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Attorney Customer No. 27682

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re U.S. Patent Application of:

Jens PETERSEN

Serial No.: 09/938,668

Filing Date: August 27, 2001

Group Art Unit: 1615

Examiner: Carlos Azpuru

Title: POLYACRYLAMIDE HYDROGEL FOR ARTHRITIS

Director of the United States Patent
and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT
UNDER 35 U.S.C. § 121

Sir:

The present communication is responsive to an Office Action dated September 29, 2003 in the above-captioned application (the "Application") requiring a restriction of the claims submitted for examination. Applicant thanks the Examiner for the courtesy of a facsimile copy of the Office Action on September 25, 2003 in advance of the September 29, 2003 mailing date.

Claims 1-8 and 17-44 are currently pending in the Application. In the Office Action, it was asserted that the Application contains claims which are directed to distinct inventions.

As a result, the Examiner issued a Restriction Requirement requiring the election of a single group of claims for prosecution. The claims, as grouped by the Examiner, appear as follows:

- I. Claims 1-8, 41-44, drawn to a hydrogel, classified in class 528, subclass 310+

II. Claims 17-26, 36-39, drawn to a method of preventing arthritis, classified in class 523, subclass 113+

III. Claims 27-35, 40, drawn to a prosthetic device, classified in class 424, subclass 423+

Applicant respectfully traverses the Restriction Requirement.

In the Office Action it was asserted that inventions identified in the above-identified groups were distinct for several reasons:

First, it was asserted that Group I and Group II are related as product and process of use. It was stated that distinctness was proven if either or both (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process. It was asserted that the claimed hydrogel can be used as a bone filler.

It was further asserted by the Examiner that Group I and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are said to be distinct if they are shown to be separately usable. It was asserted that Group II [sic] has separate utility such as treatment for arthritis.

Lastly, it was asserted that the claims of Group II and Group III, like Groups I and II, were related as product and process of use. It was asserted that the product of Group III can be used to augment or replace cartilage.

Applicant notes that under the patent statute, 35 U.S.C. § 121, an application may be properly required to be restricted to one of two or more claimed inventions, only if they are able to support separate patents and they are either independent or distinct. 37 C.F.R. § 1.141; MPEP

803. However, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits, even if it includes claims to distinct or independent inventions. MPEP 803.

The claims of Group I relate to a hydrogel for use in the treatment of arthritis. One of skill in the art will understand that claims to a prosthetic device introduced into an intra-articular cavity of a joint (Group III) are also directed to a treatment for arthritis. Applicant submits that one of skill in the art would also recognize that the inventions of Groups I and III are similar and examination of both groups in a single application would not seriously burden the Examiner.

Furthermore, the Applicant respectfully disagrees with the Examiner's restriction requirement relating to Groups II and III. The Examiner suggested that Group II and Group III would not require a separate search. Office Action at 3. Accordingly, Applicant respectfully suggests that the Examiner would not be seriously burdened in examining these two groups of claims in the same application.

Applicant submits that the claims of the designated groups have not necessarily acquired a separate status in the art for examination purposes, notwithstanding possible different art classifications which may have been artificially assigned thereto in the Patent Office. Art very relevant to the patentability of one group might logically be found in the art classes assigned to one of all of the other claim groups. The classification cited in support of the election requirement is merely used for cataloging purposes and is not conclusive of the propriety of such a requirement.

Applicant respectfully requests the Examiner reconsider the Requirement for Restriction in light of the foregoing remarks and in light of TC1600's "Restriction Practice Action Plan"

announced October 6, 2003 and that all of claims 1-8 and 17-44 be examined in the same application.

Notwithstanding the above, in order to comply with the Restriction Requirement, Applicant elects with traverse, the claims of Group II for further prosecution, and requests that the remaining claims be held in abeyance under provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

If the Examiner has any questions regarding the election of the claims of Group II, the Examiner is invited to contact the Applicant's undersigned representative for a telephone conference.

Date: October 27, 2003

Respectfully submitted,

By: 

Stanislaus Aksman
Registration No. 28,562
Shawn K. Leppo
Registration No. 50,311
(804) 788-8516 (direct telephone)

Please direct all correspondence to:

Stanislaus Aksman
HUNTON & WILLIAMS, LLP
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(202) 955-1926 telephone number
(202) 778-2201 facsimile number